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**REMARKS**

**INTRODUCTION**

The Applicant requests reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 3, 11-15, 17, and 19-21 are pending in the present application. Claims 3, 11, and 17 are the independent claims.

Claims 3, 11, and 17 are amended herein.

Claims 1, 2, 4, 5, 9, and 10 are cancelled herein without prejudice or disclaimer.

Initially, the Applicant notes claims 11-15 and 21 were indicated as containing patentable subject matter and would be allowed if rewritten in independent form to include all the limitations of their base claims and any intervening claims. By the present amendment, the Applicant has respectfully maintained claim 21 in dependent form because it is believed, at least for the reasons discussed below, that its respective base claim is allowable. By the present amendment, the Applicant has rewritten claim 11 in independent form to include all the limitations of claims 9 and 10. As such, the Applicant respectfully submits that claims 12-15, which depend from claim 11 are in condition for allowance.

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Fukuda et al. (U.S. Patent No. 6,351,440) and in the alternative, claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuda et al. (U.S. Patent No. 6,351,440).

Claim 3 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Hirashima (U.S. Patent No. 6,377,527) and also under 35 U.S.C. § 102(e) as being anticipated by Yen et al. (U.S. Patent No. 6,097,680).

Claims 17-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yen et al. (U.S. Patent No. 6,097,680).

Claim 4 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Fukuda et al. (U.S. Patent No. 6,351,440).

Claims 2 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuda et al. (U.S. Patent No. 6,351,440) in view of Fueki et al. (E. P. No. 0 833 328 A2).

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over

Fukuda et al. (U.S. Patent No. 6,351,440) in view of Hirashima (U.S. Patent No. 6,377,527).

Claims 9 and 10 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuda et al. (U.S. Patent No. 6,351,440) in view of Minase (U.S. Patent No. 6,111,826).

The Applicant requests entry of this Rule 116 Response because it is believed that the amendment of claim 11 puts claims 11-15 into condition for allowance as suggested by the Examiner. Furthermore, the amendment of claims 3 and 17 should not entail any further search by the Examiner since no new issues are being raised. The amendments do not significantly alter the scope of the claims, and at least place the application into a better form for purposes of appeal.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

No new matter is being presented, approval and entry of the forgoing amendments is respectfully requested.

#### **ATTORNEY DOCKET NUMBER**

The Applicant initially notes that the Attorney Docket No. on the cover sheet of the Final Office Action is incorrect. The Office Action lists the Attorney Docket No. as "1293.1333/MJB." The Attorney Docket No. should read "1293.1133/MDS." The Applicant respectfully requests that the Examiner change the Attorney Docket No. accordingly.

#### **FINAL ACTION PREMATURE**

The Applicant respectfully submits that the finality of the last Office Action was premature, and hereby requests reconsideration and withdrawal of the final rejection.

Under MPEP § 706.07(a), a second action on the merits shall be made final, "except where the examiner introduces a new ground of rejection that is neither necessitated by

applicant's amendment of the claims nor based on information submitted in an information disclosure statement." In the present Action, the Examiner introduces new grounds for the rejection of claims 1, 3, 9, 10, and 18-20. The Applicant respectfully submits that these new grounds for rejection were not necessitated by amendments to the claims.

Specifically, claim 1, which was not amended, faces a new rejection under 35 U.S.C. § 103(a) as being unpatentable over Fukuda et al., and claim 3, which was likewise not amended, faces a new rejection under 35 U.S.C. § 102(e) as being anticipated by Yen et al.

Furthermore claims 9-10 face a new rejection under 35 U.S.C. § 103(a) as being unpatentable over Fukuda et al. in view of Minase. While claim 9 was amended, it was amended to recite the limitations formerly found in cancelled claims 6-8 which were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuda et al. in view of Hirashima. Therefore, the amendment of claim 9 did not necessitate a rejection under newly cited art.

Lastly, claims 18-20 face a new rejection under 35 U.S.C. § 102(e) as being anticipated by Yen et al. Claims 18-20 do depend from amended claim 17, however, claim 17 was amended to recite the limitations of cancelled claim 16. This amendment did not change the scope of claims 18-20, and therefore the new ground for rejection was not necessitated by the amendment, and the finality of the rejection is premature.

#### **PRIOR ART UNDER 35 U.S.C. §102(e)**

On pages 9-10, item 11, of the Office Action, the Examiner stated that the Applicant may not rely on foreign priority papers to overcome the citation of Hirashima (U.S. Patent No. 6,377,527) because a translation of said papers was not made of record in accordance with 37 CFR 1.55. The Applicant has submitted a verified translation of the priority document along with this response, and hereby submits that the claim of foreign priority is properly made.

Accordingly, the Applicant submits that the date of invention for the above referenced application is on or before July 8, 1999. Specifically, the Applicant submits that the date of filing of the corresponding Korean Patent Application No. 99-27456 upon which priority has been claimed establishes a reduction to practice on July 8, 1999.

Since Hirashima (U.S. Patent No. 6,377,527) has a U.S. filing date of December 23, 1999, it is respectfully submitted that the Applicant's date of invention on or before July 8, 1999 predates the U.S. filing date of Hirashima. As such, Hirashima no longer qualifies as prior art

under 35 U.S.C. § 102(e) since the invention was not "described in a patent granted on an application for patent by another filed in the United States *before the invention thereof by the applicant for patent.*" MPEP 2136.05, MPEP 715.

#### **CANCELLATION OF REJECTED CLAIMS**

On pages 2 and 3, item 2, of the Office Action, the Examiner rejects claim 1 under 35 U.S.C. § 102(e) as being anticipated by Fukuda et al. (U.S. Patent No. 6,351,440). Likewise, claim 4, was rejected on pages 4 and 5, item 5, of the Office Action under 35 U.S.C. § 102(e) as being anticipated by Fukuda et al. (U.S. Patent No. 6,351,440).

On pages 5 and 6, item 6, of the Office Action, the Examiner rejects claims 2 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Fukuda et al. (U.S. Patent No. 6,351,440) in view of Fueki et al. (E. P. No. 0 833 328 A2).

As a point of clarification, claims 1, 2, 4, and 5, have been cancelled by the present amendment without prejudice or disclaimer. As such, the Applicant respectfully submits that the rejection of these claims is deemed moot.

#### **REJECTION OF THE CLAIMS UNDER 35 U.S.C. § 102(e)**

On page 3, item 3, of the Office Action, the Examiner rejects claim 3 under 35 U.S.C. § 102(e) as being anticipated by Hirashima (U.S. Patent No. 6,377,527). As discussed above, the Applicant has submitted a certified copy of the priority document upon which the present application depends. As such, the citation of Hirashima is not available as prior art under 35 U.S.C. § 102(e). Therefore, the Applicant respectfully submits that this rejection is deemed moot.

On page 3, item 4, of the Office Action, the Examiner rejects claims 3 and 17-20 under 35 U.S.C. § 102(e) as being anticipated by Yen et al. (U.S. Patent No. 6,097,680). The rejection is respectfully traversed and reconsideration is requested.

As a point of clarification, independent claims 3 and 17 has been amended to recite maintaining the pickup head in a fixed position while the traverse pulses/signals are counted/detected.

The Examiner cites Yen et al. as disclosing counting track traverse pulses, "when a tracking loop is switched to 'OFF'." The Examiner further details this rejection on page 4, paragraph 2, of the Office Action, which states, "Yen discloses a pick-up unit that reduces the track correction gain while the tracking traverse signal is being detected. The examiner notes

that the reduced track correction gain state is interpreted as a tracking 'OFF' state." The Applicant respectfully submits that Yen et al. can not function with a recording head that is maintained in a fixed position. As disclosed in col. 3, line 64 through col. 4, line 26, of Yen et al., the operation of Yen et al. depends on the reading head following a track as the disc is rotating. Yen et al. explains that while following the track, the track correction gain is reduced so that the reading head recovers more slowly from track deviations in order to allow the track servo circuit to generate a deviation signal.

Amended claims 3 and 17, however, recite maintaining the pick-up in a fixed position, i.e. not following a track. As such, the Applicant respectfully submits that claims 3 and 17 are in condition for allowance, and further, that claims 18-20, which depend from claim 17, are also allowable for at least the same reasons as their base claim as well as for the additional features that they recite.

#### **REJECTION OF THE CLAIMS UNDER 35 U.S.C § 103(a)**

On pages 6 and 7, item 7, of the Office Action, the Examiner rejects claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Fukuda et al. (U.S. Patent No. 6,351,440) in view of Hirashima (U.S. Patent No. 6,377,527). As discussed above, the Applicant has submitted a certified copy of the priority document upon which the present application depends. As such, the citation of Hirashima is not available as prior art under 35 U.S.C. § 102(e) and is therefore not available as prior art under 35 U.S.C. § 103(a). Therefore, the Applicant respectfully submits that this rejection is deemed moot.

On pages 7 and 8, item 8, of the Office Action, the Examiner rejects claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Fukuda et al. (U.S. Patent No. 6,351,440) in view of Minase (U.S. Patent No. 6,111,826).

As a point of clarification, by the present amendment, the Applicant has cancelled claims 9 and 10 without prejudice or disclaimer, thereby rendering the rejection moot.

#### **CONCLUSION**

The Applicant respectfully submits that independent claims 3, 11, and 17 of the present invention patentably define the present invention over the citations of record. The dependent claims 12-15, and 18-21 should also be allowable for at least the same reasons as their respective base claims, and further due to the additional features that they recite.

The Applicant believes that the present Amendment is responsive to each of the points

raised by the Examiner in the Official Action.

There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

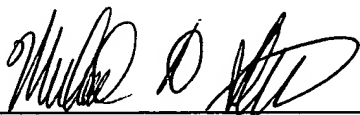
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 3/25/04

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